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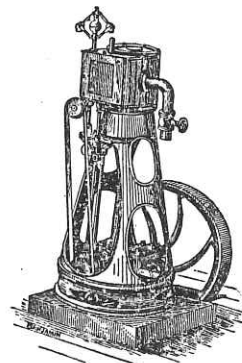
UNITED STATES PATENT AND

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# THE AMERICAN PATENT SYSTEM

## A PRACTICAL GUIDE

TO THE INVENTOR AND TO THE INVESTOR IN PATENTS.



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BY

D. WALTER BROWN,

Counsel in Patent Cases.

NEW YORK.

1890.

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THE ENGINEERING PRESS,  
277 PEARL STREET, NEW YORK.



THE matter in this little book was originally published in a series of articles in *The American Machinist*. They brought me so many letters of inquiry from inventors, and so many suggestions that they should be reprinted in book form, that I decided to so issue them, which I have now done.

D. WALTER BROWN,  
Attorney and Counsellor at Law,  
31 NASSAU STREET,  
NEW YORK.

NEW YORK, December 1, 1890.

## TABLE OF CONTENTS.

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CHAPTER I.—What is required of the Inventor.....	7
CHAPTER II.—Priority of Invention ; Sufficiency of the Specification ; Protection Secured by the Patent.....	12
CHAPTER III.—The Specification and Claims ; Im- portance of the Claims.....	22
CHAPTER IV.—Correcting the Patent after Issue ; Disclaimers and Re-issues.....	29
CHAPTER V.—Broadening the Claims of Patents by Re-issues.....	35
CHAPTER VI.—The Effect of Prior Foreign Patents on the American Patent.....	42
CHAPTER VII.—Proceedings at the Patent Office...	51
CHAPTER VIII.—Transfers of Patents.....	60

## THE AMERICAN PATENT SYSTEM.

### CHAPTER I.

#### WHAT IS REQUIRED OF THE INVENTOR.

AN inventor with a patent is not an odious monopolist; on the contrary, he is one of the world's benefactors, for he has given to the world knowledge which before him it had not, that is appropriate to the increase of its wealth and welfare.

This is the view of the American patent law, and on this idea our patent system is founded. In theory, a patent is a grant by the Government of a certain exclusive right of making, using, and selling to that man who has first conferred upon the people of the Government the knowledge necessary to enable them to make use of something which, before his time, they knew not how to use. On the one hand the inventor comes bringing the product of his mind, and publishing it to all the world on the records of the Patent Office. On the other

hand, in return for that publication, the Government gives to him the exclusive privilege, for a time, of making, using, and selling his invention. After that time the invention is to be free to all the world.

It is evident that this relation of the inventor to the Government involves certain indispensable conditions ; and first, that the inventor shall really be, as he professes to be, the first to make known to the world the discovery embodied in the invention and claimed in the patent ; for, if another were the first, then that other, and not the alleged inventor, would be he who had conferred the benefit. Or if, before our inventor had made his invention, the thing he claimed were generally known, then, as he would add nothing to the stock of knowledge, he would not have given the equivalent for a patent, and a patent to him would exclusively appropriate to him a right which had before belonged to all.

So, again, it is necessary, in order to obtain a patent, that the invention shall be useful ; that is, that it shall not be purely visionary and impractic-

cable, like a scheme for perpetual motion, nor aim at immoral or injurious results. But it is only necessary that some benefit shall be conferred by the invention—not a great one, but some. The law recognizes that, in general, the extent of the use of an invention, and the value of the monopoly of the patent, will depend on the usefulness of the invention, and it does not itself undertake to pronounce on the usefulness of any man's device. It merely says he must not patent an entirely frivolous, impossible, or immoral thing.

Finally, it is evident that an inventor only bestows that benefit on the world, which is the sole condition on which he can obtain a patent, when he publishes to the world so full and complete an account of his invention that another can take that account, and from it make and use the patented thing. Without such sufficient description, the primary object of our patent law—to add to the sum of beneficial knowledge—would not be attained.

Thus the patent law requires of the inventor these three things :

1. That he shall be in fact and in truth the first inventor.

2. That his invention shall be in some degree useful.

3. That he shall publish to the world, in the records of the Patent Office, an account, called a specification, sufficiently full to enable others, who are skilled in the art or business to which the invention relates, to make and use the invention. This record remains for the information of the world, so that, after the limited life of the patent, all skilled in the art may freely employ the invention.

It is the theory of our law, and the fact agrees with the theory, that the Patent Office shall be a storehouse of knowledge, useful to the world's progress. The information furnished by the inventor to its records is the benefit in return for which the Government protects him in his exclusive privileges for a limited time.

The nature of this privilege, the priority of invention, and the sufficiency of the specification will be treated of in the next chapter.



## CHAPTER II.

### PRIORITY OF INVENTION—SUFFICIENCY OF THE SPECIFICATION—PROTECTION SECURED BY THE PATENT.

OUR law requires that the patentee should be, in truth, the "first inventor." But these words have, in law, not quite so wide a meaning as they have in general use.

To be the "first inventor" does not mean that the applicant for the patent must be the first man in all the world to have devised the thing. But it does mean substantially this :

1. That the applicant for the patent shall be the first man to have invented that thing in the United States : and

2. That the same device, if before invented in a foreign country, shall not have been patented or described in any printed publication anywhere before the American applicant invented it.

So a foreign inventor may have first invented and used the thing abroad, but that will not prevent the American from getting his valid patent here; if the foreign invention was not patented or described in any printed publication before the date of the American invention.

Furthermore, it is not every prior foreign patent or publication which will prevent the American from getting his valid patent, but only such foreign descriptions as are so clear and complete that a skilled person can take the foreign description, and from it make and use the same thing substantially as the American invention. Thus, for instance, a passing notice of a foreign invention in a report of a scientific society will not affect a later American patent. In short, the foreign description must be substantially as full and complete as it would have to be in the specification of an American patent.

Again, the meaning of the words "first inventor" must be restricted so as to meet cases like the following, which are of very common occurrence :

Suppose A is the first to conceive the idea of an

invention, but B, who does not conceive the idea until after A, is more expeditious with his investigation and experiments, and gets practical results before A does. Which of the two men is the "first inventor?"

It is first necessary to understand what is meant by "conception of invention." A failure to comprehend this has caused to many the loss of valuable properties, or has led them into useless and costly litigation.

"Conception of invention" includes the two following things:

1. That the inventor has got an idea that it would be well to do a certain thing.
2. That he has got an idea of the *means to do it*, substantially the same as the means he describes in his patent (supposing he applies for a patent). Only when he has got both these ideas has he "conceived of an invention" in such a way as to give him any rights. To merely get the idea that it would be well to do a certain thing amounts to nothing. Many a man is ignorant of this, and

goes about claiming to be the inventor of something which some other has used or patented, simply because he (the claimant) first got the idea that that was a good thing to do.

But such a claim is idle. The law takes no note of it until it is shown that the man had also an idea of the means for doing the thing. But, granting that A has such a complete "conception of invention," then the answer to the case supposed is this:

If A, having made this conception of invention, is as diligent as his health, his means, and the general circumstances of his life admit, in completing his experiments and reducing his invention to practical shape, then A is the "first inventor," and entitled to the patent, although B first got a practical result.

But if A is negligent, and does not prosecute his experiments to a practical result as rapidly as he reasonably can, then his negligence forfeits his rights, and B is entitled to the patent.

The very great importance of establishing the date of the "conception of the invention," and diligence in perfecting it, become apparent.

An inventor who has conceived of an invention should proceed with all practicable speed to bring his experiments to a point where they can be practically demonstrated. To sleep by the way may be fatal.

When he has got the idea of what he proposes to do, he should, at the earliest possible time, note down a brief statement of what he intends to accomplish, and the means he intends to use; in other words, make a brief description of his invention. He should make a rough, but substantially accurate sketch of his apparatus, and as any important step is taken in his experiments it should be noted down. The final clear result should be noted carefully. It requires but little pains to do this. A small memorandum, which should have the dates carefully noted, is sufficient. The thing is to get a record which will be proof of the clear, continued direction of the inventor's mind to the subject, from the first conception to the practical result, which record will show that his was more than a mere hap-hazard idea which ended in nothing.

For lack of such evidence many an inventor has lost the fruit of his toil, because he could not prove he had ever advanced beyond the first crude, incomplete idea.

Another question, which is closely connected with that of "first invention," and one which frequently arises, is the following: When a workman, in the employ of another, is directed by his employer to make a certain thing, and does make it, is the employee or the employer the inventor? As to this—

1. The law gives to every man, whether he be employer or employee, the patent for what that man invented; but

2. If an employer has conceived of the invention, as I have before explained, and tells the employee to make the thing, giving him the general idea of the thing to be made, then the employer is the inventor and entitled to the patent. In this case, the skilled work of the employee gives him no claim to the patent.

So, generally, when an employer has given such a general idea of the whole machine to the em-

ployee, any improvement which is designed by the latter while making the machine belongs to his employer ; but

3. If an employer merely suggests to his employee that it would be well if a certain thing could be done, and the latter goes ahead and devises the means to do it, then the employee is the inventor, and entitled to the patent ; and, finally—

4. If an employee makes an invention in the time of his employer, and with his employer's tools, etc., then, although the employee is the inventor, he will generally be held to have given his employer a license to use the particular machines so made, without fee.

#### THE DESCRIPTION IN THE SPECIFICATION.

When taken with the drawings of the patent, the description must be so clear and complete that the reading of it will give to a person, skilled in that special line of business, all the information he needs to make and use the thing. It is not necessary, however, that the specification should be so full as to instruct one who knows nothing of the subject

how he can go to work to make and use the thing. Patent specifications are not primers for primary schools—they are directed to the men who understand that particular business, and it is absolutely necessary they should give those men all the information needed, *without any further experiment*, to make and use the invention. A specification which does this is sufficient.

#### THE PROTECTION CONFERRED BY THE PATENT.

THE patent, when granted, gives to the inventor and to those to whom he sells any part of the patent, the exclusive right for seventeen years of making, using, and selling the invention in all parts of the United States and their territories. During the life of the patent no other person than the inventor, or those to whom he sells the right, can either make, use or sell the invention in any part of that territory. These rights are enforceable in the United States courts, where, by proper suits, the inventor, or his assignees or representatives, can prosecute any one who, in any part of the

country, at any time during the seventeen years, does either of the above things without authority.

In such suits, the inventor, and his assignees and representatives, can obtain damages for past infringements, can compel the infringer to discover whatever profits he has made out of his unlawful use of the invention, and can obtain injunctions restraining the infringer from making any further use of the invention thereafter, unless he obtain from the inventor, or other owner of the patent, authority to use it.

Of course the patent gives to the inventor, and his assigns and representatives, the right to grant licenses, shop rights, etc., for making, using or selling the invention, and no others have the right to grant any such licenses.

The patent secures all these various privileges to the inventor for seventeen years, and no longer. A patent cannot be extended beyond the first seventeen years, except by a special Act of Congress. Practically, it may be said, a patent cannot be extended at all.

When an inventor sells a part, as say a half interest in his patent, intending the patent shall be worked for the joint benefit of himself and his assignee, it will often be of very great importance that the exact rights and obligations of each party be carefully set out in the assignment. It is very common to draw assignments of part interests so that the inventor simply sells the half or other interest generally, without any statement of the exact rights and obligations of each party. When this is the case, the law is very unsettled as to what remedy, if any, either party has against the other for proceeding to realize more than his share out of the patent. Thus, in such case, if one of the owners of the patent should go ahead and grant licenses all over the country, it is not by any means settled what remedy the other would have. Therefore it will often be of great importance that the assignment be very precise about all this; as, for example, that no licenses shall be granted except by all the owners of the patent jointly, and that all proceeds or net proceeds, shall be apportioned in the certain specified way.

## CHAPTER III.

THE SPECIFICATION AND CLAIMS—IMPORTANCE OF  
THE CLAIMS.

THE law requires that besides describing his invention in the specification so clearly and completely that others can make and use it, the inventor shall also "particularly point out and distinctly claim the parts, improvements, or combination of parts, which he claims as his invention or discovery."

The claims are the well-known short-numbered paragraphs placed at the end of the specification, and immediately before the signature of the inventor. They are inserted in the patent in order to inform the public just what parts of all the things stated in the whole of the description are the invention, which the inventor alone shall have the right to use, and which are withdrawn from the public.

The primary reason, therefore, for adding claims to patents is to protect the public.

When we reflect that the great majority of the patents of to-day are improvements on earlier machines, which, of course, the inventor has not invented as a whole, the necessity of claims to define the invention becomes evident.

In order to clearly explain the inventor's specific improvement, it is usually necessary to describe also many parts of the machine which he did not invent. Therefore, if there were no concise and specific statements of just what his invention is, it would, in such cases, be very difficult to determine what the patent really covered. Clearly it could not cover all the things in the specification, since many of them would be old, and there would be no information in the document as to just what parts of it were the inventions. It is the purpose of the claims to give this exact information.

From this follows the rule of law that no patent is infringed, unless some one, at least, of its claims is infringed, and the infringement of any one claim is an infringement of the patent to that extent.

Therefore, if the claims of a patent are carelessly drawn, so that it is possible to make substantially that same machine, but with such changes that it does not reproduce all those parts which are recited in any claim of the patent, that machine will not infringe the patent, and it may be made and used in spite of the patent.

An explanation is required here—

1. Another than the inventor cannot take all the parts found in a claim of the patent and add others, and then use that total combination. That will be an infringement of the patent.

2. He can take less than all the parts of a claim and use them, for the use of less than all the parts of a claim does not infringe a claim, and he can, of course, take less than all the parts of the claim, and add other new parts, and use the whole combination.

Briefly, a claim is infringed by taking all its parts, and adding others to them; it is not infringed by using less than all its parts, whether or not other new parts are added.

In recent years, particularly since 1882, the courts have strictly held that no part of the specification shall be considered to be an invention, unless the specification and claims distinctly state that such part is the invention intended to be protected by the patent.

Now the only parts of the specification which state this are, usually, the brief paragraph near the beginning of the specification, in which the purpose of the invention and the means used are concisely presented, and the claims. No matter what things may be shown in the drawings, or described in the descriptive parts of the specification, they will give no protection to the inventor, unless those things are distinctly stated to be parts of his invention, which he claims. In default of such distinct assertion, the courts will hold, either that the things described are old, or that the inventor intended to give them freely to the public.

The supreme importance of the claims and the paragraphs referred to is evident.

The paragraph should define in the broadest

terms possible, in any case, the objects of the inventor and the means he uses. This immediately gives to the patent a broad and valuable character, prepares the way for broad claims, and tends to prevent a contestant from narrowing the meaning of the claims.

After the description should follow the claims, which may be divided in two great groups. 1. Those in which the general aspect of the invention are stated in the broadest terms with which it can be intelligently described. 2. Those in which the invention is set forth in detail in the various combinations of parts shown in the patent.

Very often the invention aims at some very broad and general result which is new. Then the thing is to discover the simplest combination of fewest parts which will accomplish that result. These parts, and only these, should then be stated in a claim. This claim will be the corner-stone of the patent.

Next, study of the specification, drawing and model will show that the general result can be got

by a combination of a few parts constructed in the particular way described in the specification. A claim should be added for just those parts, and no more, constructed in that particular way. This will also be a broad claim, but not so broad as the former, because the terms used in it are not so general.

Then, usually, there are several other combinations of parts which act together to produce some result in the machine, and which are new combinations. Each of these combinations should be stated in a separate claim, in no one claim using any more parts than are necessary to give a working result, and using as broad terms as possible in naming each part.

Again, there will often be some single features which are new in themselves. There should be a claim for each of these.

Thus the claims of a patent are like a pyramid, or rather perhaps a pyramid inverted. First, the broad claim on the principle and the means (not the principle alone, for that is not patentable); then



the claims on the single elements; then the claims on the combinations of parts, first of fewer, then of more parts, until at last all the novel elements or combinations are united in one long detailed claim.

Thus the drafting of the specification and the claims becomes a highly technical, precise and difficult matter, in which the inventor cannot exercise too great care. Two recent great cases—viz., the telephone suits and the Morley sewing machine suit, have established the right of the inventor to the use of very broad and general language in his claims, and the present Commissioner of Patents is showing a like liberal spirit. If, therefore, the specification and the claims are properly drawn, no matter how general the terms, if they are true statements of facts, the opportunity for obtaining a broad patent, and defending it in the courts, is better than it has for some time been.

#### CHAPTER IV.

##### CORRECTING THE PATENT AFTER ISSUE—DISCLAIMERS AND RE-ISSUES.

It frequently happens, that after an inventor has obtained a patent for a *bona-fide* invention, the patent is found to be invalid, because either (1) the inventor has claimed things which he did not invent, as well as those which he did invent; or (2) the description and claims of the patent are too incomplete or too vague to furnish that full and clear information respecting the device and the claims, which the law requires.

In such case, our statutes say that the patent shall be valid for those things which the inventor did actually invent, if he will correct his patent so as to make those things clear, and so as to claim no more than those.

The methods of so correcting a patent, after it has issued, are two:

1. By disclaimers.

## 2. By re-issued patents.

A "disclaimer" is what its name implies—to wit, a statement added to a patent, to the effect that certain things claimed in the patent are not the invention of the inventor who took out the patent.

This statement is made by an instrument in writing, addressed to the Commissioner of Patents, and signed by the patentee, or his assignee, and attested by witnesses. The disclaiming part runs substantially thus:

"Your petitioner hereby enters his disclaimer to that part of claim No. —, which is in the following words :"

[Then follow the words setting forth the things which were not first invented by our inventor.]

When such a disclaimer is filed, its effect is to limit the patent to what is the actual invention, and for all that not disclaimed the patent is valid.

In fact, even without the actual filing of a disclaimer, a patent is good for all those things which were the actual invention of the applicant, and a patentee can bring suit for infringement of such

patent, before he files a disclaimer; but he cannot recover his costs in a suit unless the disclaimer was filed before the suit was commenced; and should he delay to file a disclaimer for an unreasonable time after he discovers that his patent claims more than he actually invented, he cannot maintain a suit on it

No man is required to file a disclaimer before he has reasonably conclusive proof that his patent claims too much, and he has a reasonable time to file it after such proof is given to him.

A disclaimer is proper when a patentee claims more than he had a right to claim; it is not proper when he claims not simply more than he has a right to claim, but some different thing; or when the specification and claims are not sufficiently complete and clear.

In these cases the correction should be made by a re-issued patent, not by a disclaimer. The difference is this: A "disclaimer" is a brief statement that some particular things claimed in the original patent are not inventions; a "re-issued patent"—

commonly called "re-issue" for short—is another complete patent—description, claims, and all—which takes the place in all respects of the original patent, and runs until the end of the original term. Thus, if an original patent were granted in January, 1890, to run until January, 1907, and a re-issue were taken out in 1895, that re-issue would run only until January, 1907.

A re-issue is not an extension of the original patent, but is simply a corrected patent, which takes the place of the original in all respects. The original patent is surrendered to the Commissioner of Patents when the re-issue is canceled and then ceases to exist.

The cases provided for by statute, when a re-issue can be taken, are the two stated at the beginning of this chapter—viz., (1) when the original patent claims more than the actual invention. (2) when the specification and claims of the original are not so clear and complete as the law requires them to be.

The statutory reasons for taking re-issue are,

therefore, (1) to limit the patent down to the actual invention; (2) to substitute a clear and complete description and claims of the exact thing invented for imperfect ones.

For the former purpose a disclaimer may also be used, and a disclaimer is cheaper, and, perhaps, safer. For the latter purpose a re-issue only is proper.

In taking out a re-issue, the inventor must address a petition to the Commissioner of Patents, make a new oath of invention, and file a new specification and drawings, and state under oath the defects in the original patent. The oath of invention and the oath as to defects are united in a single affidavit.

The law requires that the specification of the re-issue shall not contain any description of a material thing which was not described in the original specification, and that the claims of the re-issue shall not include any invention which was not claimed in the original patent, or at least there distinctly stated to be a part of the invention intended to be claimed.

Our law limits a re-issue to the correction of defects of description, and to the removal of claims which could not be properly claimed. It does not permit a re-issue to add any substantial thing not contained in the original patent, nor to have claims broader than the original claims.

A re-issue which does either of these forbidden things is void.

There is, however, a certain class of re-issues, not expressly provided for by law, but allowed by the courts, which may have broader claims than the original patent had. To distinguish the two kinds, I have termed those described in this chapter "statutory re-issues," that is, re-issues expressly authorized by law, and the others "equitable re-issues." These latter will be discussed in the next chapter.

## CHAPTER V.

### BROADENING THE CLAIMS OF PATENTS BY RE-ISSUES.

WE saw in the last chapter that our patent laws permit a patent to be corrected, after it has issued, by *disclaimers and re-issues*, but that only those patents can be so corrected which claim more than the inventor has a right to claim, or which do not fully and clearly describe and claim the invention.

We also saw that the re-issues provided for by the letter of the law could not be used to broaden the claims of the original patent, even in those cases where the inventor was justly entitled to the broader claims.

There is, however, a class of re-issues which are not expressly authorized by the statute, but are permitted by the courts for this very purpose of broadening the claims of the original patent, so that the re-issue shall protect all that the inventor has a right to.

The circumstances in which this latter class of re-issues are permissible have been carefully defined by the Supreme Court, and a re-issue which is granted under other circumstances is void.

The conditions in which alone a valid re-issue for the purpose of broadening the claims of the original patent can be granted are the following: 1st. Some genuine mistake must have been committed in draughting the specification and claims of the original patent, or during the proceedings in the Patent Office before the patent is granted; by reason of which mistake some essential thing which the inventor intended to incorporate into his original claims has been omitted from the original patent.

An example of the kind of mistake meant is this: An inventor desired to claim a certain feature in a machine, and so informed his attorney, who inserted the proper claim in the specification. But during the proceedings at the Patent Office, before the patent was granted, the claim was by some oversight dropped from the papers, and omitted from the patent. This was a case of such

mistake as entitled the inventor to a re-issue, which was broader than the original patent, since it included a claim on a feature which was not claimed in the original patent.

The mistakes which authorize the grant of a valid re-issue must be of this general type. There must be some accidental blunder, no matter by whom made, in consequence of which, something which the inventor intended to include in his description, and to claim, has been omitted from the claim, or from both description and claim.

Unless such a mistake has been committed, the Commissioner of Patents has no authority to grant a re-issue with the broader claims, and if he should grant it, the re-issue would be void. The existence of the mistake is the indispensable condition for the granting of the re-issue.

Secondly, the application for the re-issue must be made as soon as possible after the grant of the original patent. Any considerable delay on the part of the inventor in applying for the re-issue will deprive him of his right to the re-issue, and should

the Commissioner grant it after such delay, the re-issue will be void.

How long a time may elapse after the grant of the original patent, before the application for the re-issue, is uncertain, and will depend on circumstances. If some other manufacturer has begun to make a thing like that described in the patent, before the re-issue is applied for, and if that thing does not infringe the narrow claims of the original patent, but does infringe the broad claims of the re-issue, then a short lapse of time will deprive the inventor of his right to the re-issue. Generally a re-issue cannot be granted after such manufacture has been begun by some other party, for an inventor is not permitted to obtain a re-issue for the purpose of forcing a manufacturer out of business, who has begun to make a thing before the re-issue was applied for.

But if no other manufacturer or inventor has begun to make similar things, then even a considerable lapse of time may not deprive the inventor of his right to a re-issue; for in this case no one is injured by the re-issue.

Yet, as a rule, a delay of more than two years is dangerous; for the courts will look with suspicion on a re-issue granted after a greater lapse of time than two years.

When properly granted, these re-issues have a very important quality. We saw in the last chapter that the other class of re-issues, which are expressly provided for by the terms of the statute, cannot claim any substantial thing not claimed in the original patent, and that a re-issue violating this restriction is void.

But those other equitable re-issues are not subject to this restriction. In fact, the very reason why they are allowed is that they may include inventions which were omitted from the original patents by mistake.

Therefore, under the circumstances which I have stated above, an inventor can include in one of these re-issues any substantial part of the invention which could have been included in the original patent, and which the inventor intended to so include, but which was omitted

from that original patent by some accidental mistake.

The purpose of these equitable re-issues is to protect the inventor from mistakes, and to secure to him the whole extent of his invention, whether it is all included in the original patent or not.

The right to take out such a re-issued patent will sometimes be of immense value; for, by such a re-issue, a patent originally narrower than the invention, and of little value, may be broadened up to the scope of the invention, and control a great industry.

But the granting of such re-issues is most jealously restricted by the courts, and the re-issue must comply with the restrictions which are now established, or it will be void.

I state again the conditions for the granting of a valid broadened re-issue.

1. There must have been some blundering mistake in connection with the granting of the original patent. If there was no such mistake, the re-issue will be void.

2. Application must be made for the re-issue as soon as possible—before any other manufacturer has come into the field, and generally before the lapse of two years after the granting of the original patent.

Do not delay in applying for a re-issue; delay may be fatal.

## CHAPTER VI.

### THE EFFECT OF PRIOR FOREIGN PATENTS ON THE AMERICAN PATENT.

It often happens that a foreign inventor who has patented his device abroad, afterwards obtains a patent in the United States; and, not seldom, through various circumstances, an American inventor obtains a foreign patent before his American patent is granted.

In all such cases, and without regard to whether the inventor is an American or a foreigner, our law says that :

“No person shall be debarred from obtaining a valid patent here, by reason of that invention's having been before patented in a foreign country, unless the invention has been in public use in the United States for more than two years before the American patent is applied for.”

That is to say, the fact that an inventor has patented his invention abroad will not prevent his

afterward obtaining a valid patent here, unless, in some way, the invention has come into use here more than two years before the American patent is applied for.

But in these cases of prior foreign patents on the same invention, our statutes limit the duration of the American patent in the following manner :

Every American patent granted for an invention which has been previously patented abroad, expires at the same time as that foreign patent expires; or if there are more than one foreign patent, then the American patent expires at the same time with the foreign patent which has the shortest term to run.

Thus, if, before obtaining an American patent, the inventor had taken out several foreign patents, the American patent would expire with that foreign patent which first expired.

Now, in the interest of justice to the inventor, and of common sense as well, the question has often been asked : Does the American statute mean exactly and literally what it seems to say, that—viz.: the American patent shall expire at the same



time with the foreign patent, which was granted *before the American patent was granted?* or does it really mean that the American patent shall expire at the same time with the foreign patent, which was granted *before the American patent was applied for?*

The distinction is of great importance; for, if the latter meaning were correct, then, if an American inventor applied in good faith for an American patent, before he applied for a foreign patent, that foreign patent could not limit the American patent, no matter whether the foreign patent were actually first granted or not.

This is the view of justice, and of enlightened common sense, but, unfortunately, the words of our statute are so precise that the courts have hitherto felt obliged to decide that an American patent is limited to expire at the same time with the foreign patent which was first granted, even if the American patent was first applied for.

In practice, the unfortunate result is this: An inventor applies first for an American patent; then

he applies for a foreign patent. But by reason of the careful examination made by our Patent Office, and the unavoidable delays in our practice, the foreign patent is first granted. That patent will limit the life of the American patent, although the inventor first applied here for his patent.

Again, in some foreign countries the laws are such that, if an American patent is published in the reports of our Patent Office, or particularly in the full specifications which are regularly issued here, a valid patent in those countries cannot be obtained.

Thus the American inventor is at times between the devil and the deep sea, liable to be devoured here, or drowned there.

The procedure for such cases is the following: Apply first for the American patent, and prosecute it through the Patent Office, until you are notified that the patent is allowed, then decide on some date (a Tuesday) on which the foreign patents are to be entered; pay your United States fee on such a day that the American patent shall issue on the

Tuesday decided upon, and arrange with your foreign agent to have the foreign applications entered on that same day, or as soon thereafter as possible. Thus you will, by aid of considerable ingenuity, save both your American and your foreign patent.

Again: In some foreign countries a patentee may either pay the whole fee (a very large sum often) at once, and take out a patent for the full foreign term, or he may pay a certain part only of the fee, and take out a patent for only a part of the full term, with the privilege of extending the patent up to the full term, by subsequent payments of the remaining fees.

Now in such cases it was formerly held by our courts that if, for example, an inventor paid the five year fee and took out a five year foreign patent before he obtained his American patent, and afterward extended his foreign patent to its full term of fifteen years, the American patent should nevertheless live only to the end of the first five years, and then expire.

Fortunately, however, the Supreme Court has recently decided that in every such case, where the patentee keeps his foreign patent alive to the end of the full foreign term, the United States patent shall also live to the end of that full foreign term, no matter how short a time the first foreign fee was paid for; but provided that the American patent shall never live more than seventeen years.

Once more: In some countries there are various provisions of law requiring the payment of certain stamp duties, or the manufacture of the invention in those countries, etc., etc., and the failure to perform any of these requirements will invalidate the foreign patent.

Now, suppose an American inventor has been so unfortunate as to obtain a foreign patent before he got his United States patent, and that by the failure to perform some of the above requirements, the foreign patent speedily lapses. Will that lapse also kill the American patent?

As to this, common sense has always said, No! —has always said that in such a case, where a

foreign patent had been granted before the American patent was granted, and that foreign patent had been sold to a foreigner, so that the American inventor had no further control over it, then it would be most unjust and absurd to permit the acts of that foreigner in failing to pay foreign stamp duties, etc., by which the foreign patent would be forfeited, to also destroy the American patent. Yet the matter was in grave and unfortunate doubt until very recently. Now, however, the United States Supreme Court has decided that the American patent can only be limited by the length of the term which the foreign law fixes for the foreign patent, and cannot be affected by anything that may be done or omitted in that foreign country, after the granting of the foreign patent.

An American patent has now been authoritatively declared to be out of reach of foreign forfeiture.

The two decisions of the United States Supreme Court referred to above are of great value to the American inventor, for they have settled: (1) That whether an inventor pay the whole of the very

large fees required for the full foreign term, at once, or at first pay only the small fee for the first few years of the foreign patent, afterward, from time to time, paying the remaining fees in installments, in every case the American patent is valid for the whole of the foreign term. (2) That, if there is a foreign patent in force when the American patent is granted, the latter cannot be injured by any failure to observe any local duties imposed by the foreign law.

Yet, while our courts have thus relieved an American inventor from some of the inconveniences which arose from a too literal interpretation of our statutes, yet the prudent inventor will, in every case where it is practicable so to do, avoid taking a foreign patent before the American patent is granted, and will note that the practical sum of the whole matter is this:

Apply for the United States patent before you apply for the foreign patent. Do not apply for the foreign patent until you receive notice that the American patent is allowed by our Patent Office.

Then arrange, as above pointed out, that the foreign patent shall be entered on the same day (or as soon after as possible) that the American patent issues.

## CHAPTER VII.

### PROCEEDINGS AT THE PATENT OFFICE.

HAVING, in the preceding chapters set forth the salient features of our patent system, it seems well to add a brief statement of the practice before the Patent Office.

The first step in applying for a patent is the preparation of the "petition," which is a brief request directed to the Commissioner of Patents that a patent may be granted to the petitioner for the invention described in the specification which is annexed to the petition.

An inventor may conduct his case in person before the Patent Office, or he may appoint an attorney (solicitor) to conduct it for him, and the latter is the only safe course. The preparation of the claims and the proceedings at the Patent Office are too highly technical to be safely undertaken by any but specialists. An inventor who to-day attempts to

prepare and manage his own case is likely to prove a very costly attorney in his own cause.

Where a solicitor is employed he must be authorized to act by a written "power of attorney," which is filed at the Patent Office. Usually the "power of attorney" is included in the "petition."

In addition to the petition and the power of attorney, the other written documents required are the "specification" and the "oath." Each of the foregoing documents must be signed by the inventor if he is living; if not, they may be signed by his executor or administrator, and the specification also requires two witnesses.

The specification, including the claims, has been hitherto discussed. It needs only to be added that it should be clearly written or printed, and must be in the English language.

The oath is an affidavit, in which the inventor solemnly swears before a notary or other proper officer that he is the original and first inventor of the thing set forth in his specification and claims; that he does not know and does not believe that

thing was known prior to his invention of it; that it has not been patented to him or to others in any country;\* and has not been in public use or on sale in the United States for more than two years before his application for a patent.

The oath is, of course, in writing, and is signed by the inventor; annexed to it is the "jurat," or certificate of the notary that the oath was sworn before him on a certain day.

In many cases the inventor assigns his invention and the patents which may be granted therefor, to some other party. In such case the patent will issue to the assignee, if the inventor so request, in writing. This request is usually incorporated into the petition, or it may be made afterward; but, in order that the patent shall issue to the assignee, the assignment must be recorded at the Patent Office.

Generally, the assignee should have the assign-

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\*If foreign patents have been granted in any countries, the oath contains a list of those countries, and a statement that the invention has not been patented in any country except those.

ment recorded at the Patent Office as soon after it is executed as possible, in order to protect himself from surreptitious sale by the inventor to a third party.

For three months after its date, an unrecorded assignment will protect the assignee's right against subsequent parties who in good faith buy the same patent. After three months it will not protect him. The safe and proper course is to have the assignment recorded as soon as made.

In every case where the device can be shown by a drawing, a drawing is required. As many sheets of drawings may be used as are needed to contain all the views of the invention which it is desirable to give. The manner of executing these drawings is very particularly prescribed by the rules of the Patent Office, and these rules must be exactly followed.

Each sheet of drawing board must be 15"x10", and there must be a margin line all around the sheet one inch from the edge, leaving the space within the lines 8"x13". The ink must be jet black. Smooth

bristol board must be used, and the shading should not be too fine, and should be sparingly employed. The reference letters should be of good size—from an eighth to say a quarter of an inch high.

Patent drawing is an art by itself. The great need is clearness—clearness, that is, in illustrating the method of operation, and the essentials of construction. As a rule, the fewer the lines, and the simpler the execution of the drawing which will do this, the better. The elaborateness of construction drawings for engineering purposes is not desirable; would, in fact, be injurious to a patent drawing. In all cases, therefore, the drawings should be made by a special patent draughtsman, under the direction of the patent solicitor. The latter's supervision of the arrangement of the several views, with the purpose of best showing and emphasizing the salient features of the invention is of great importance. The drawing (and each sheet) must be signed by the inventor or his attorney, and be witnessed by two witnesses.

The petition and power of attorney, and the

specification and oath, should all be attached together, so that each may be identified at the Patent Office by the others, rolled with the drawings into a neat roll, and sent by mail or express to the Commissioner of Patents. At the same time a letter should be addressed to him referring to the application, and inclosing the first fee of \$15. In order to get the application on the files of the Patent Office it is necessary that the petition, specification, oath, drawings, and the first government fee shall all have been received there. The proper course is to send them all to the office at the same time.

Models are now but seldom required, and should not be sent to the Patent Office until the inventor is notified that a model is necessary. When such notice is given, the model must be furnished, or the case will not be considered any further.

When the invention is a composition of matter the Commissioner of Patents will usually require the inventor to furnish specimens of the composition and of its ingredients for experiment by the

office, and also a sample of the composition for preservation.

After the application has been received, the Patent Office conducts the examination and the proceedings prior to the allowance of the patent. Generally these proceedings take the form of notifications to the inventor that one or more of the claims as originally filed are anticipated by prior patents which are cited. To meet such objections, or any others, the specification and claims may be amended until they are satisfactory to the Examiner at the Patent Office, or until he finally rejects the application. In this latter case, the inventor can appeal to the Board of Examiners in Chief, who will review the case and give a decision for or against the application. If the board also decide against the inventor, he can appeal to the Commissioner of Patents, and from his decision the inventor may appeal to the Supreme Court of the District of Columbia. In case of an adverse decision by the Commissioner of Patents or by the Supreme Court of the District of Columbia, the

inventor may have his invention passed upon in the United States Circuit Courts.

For the making of the amendments to the specification and claims, above spoken of, the power of attorney gives the necessary authority to the solicitor, without requiring the signature of the inventor to such amendments.

The Government fees are as follows :

When the papers are filed, \$15.

After the inventor receives notice that his patent is allowed, and before it issues, \$20.

This fee of \$20 must be paid within six months after the date of the notice of allowance, or the patent will be considered forfeited, and will be withheld.

On applying for a re-issue, \$30.

There is no additional fee when the re-issue is granted.

On appealing from the Examiner to the Board of Examiners in Chief, \$10.

On appealing from the Board to the Commissioner of Patents, \$20.

When an appeal is taken to the Supreme Court of the District of Columbia, the applicant is required to pay to the Clerk of the Court a docket fee of \$10.



## CHAPTER VIII.

### TRANSFERS OF PATENTS.

I GIVE no forms of assignments or licenses, because the few which could be given in this little book would be merely "a delusion and a snare." These instruments must be specially drawn to meet each case. But there are a few points which experience shows that both the inventor and his assignee frequently overlook to their later discomfiture, and to which I wish to direct attention.

Whatever either party to the transfer of a patent or the granting of a license considers as important to him in the agreement which has been reached should be embodied in a writing signed by the other party, or by both parties if there are conditions which are to bind each, and the writing should very properly be witnessed.

If the case is that of an assignment of a patent, where the assignment is to be recorded in the Patent Office, and the parties have made an agree-

ment, some particulars of which they do not wish to make public on the records of that office, then such particulars should be inserted in a carefully drawn agreement signed by both parties, and of which each party takes a copy. This agreement should be so full and clear that there can be no doubt of the rights and obligations of each party, at least as respects all these matters which either considers to be essential considerations for the making of the agreement. Then an assignment can be drawn in the ordinary short form, wherein a nominal consideration, as "one dollar," may be stated. This latter instrument, duly recorded in the Patent Office, will transfer the title and interest in the patent to the purchaser, and will effectually protect him, while the agreement remains to show the full intentions of the parties subsequent to the transfer.

A few of the matters which experience shows are often overlooked in the draughting of agreements, and transfers of patents may be mentioned.

If the purchaser of a patent is intending to found

a business, or any branch of a business, on the patent, then it is important the agreement or assignment should stipulate that the inventor will assign to the purchaser any subsequent improvements which he may afterward invent in that particular class of machines or devices to which the patent relates. If this provision is omitted the purchaser of a patent, who has gone to large expense in erecting a plant, may find himself forced out of business by an improvement on his machinery made by the inventor from whom he purchased his patent, and transferred to competitors in the business. Where such a provision is inserted in the agreement justice may require that some compensation shall be given to the inventor for those improvements. All this should be discussed, agreed on, and provided for in the agreement.

Again: It is often the case that the real consideration to the inventor is not the money which is paid, or the stock which is delivered to him, but some future consideration, as employment in a company or business at a fixed salary. This

matter of salary is too often left to a verbal understanding. Expenses are heavy, to cut off salary is easy; the inventor is discharged, and redress is difficult or impossible, for he cannot prove that there was any explicit agreement to employ him for a definite time *as a part of the consideration for his selling the patent*. The salary and the time during which the employment is to continue should be stated in the agreement.

Once more: In licenses on payment of royalty it is well to stipulate for a minimum royalty to be paid, at all events, yearly. Otherwise the purchaser may hang the patent, up, never make the machine, never sell one, and, consequently, never have any royalty to pay. But where a minimum royalty is stipulated for, at all events, then, whether the purchaser manufacture or not, the inventor will receive that much yearly; and the fact that such a sum yearly must be paid is itself somewhat of a guarantee that the purchaser will manufacture in order to recoup himself for that necessary payment. Royalties should be either definite sums, as so

many cents for each article made or sold, according to circumstances, or a percentage of some fixed price, as price of making, or selling price. They should not be percentages of profits. Human nature is such that under such circumstances profits disappear.

These illustrations are sufficient to indicate the need of care, and particularity in draughting agreements relating to patents. The rule should be mutual justice and fair play, and the terms of such justice and fair play stated in writing.

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